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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,183	01/16/2004	Hiroyuki Mifune	FS-F03225-01	5527
37398	7590	01/28/2005	EXAMINER	
TAIYO CORPORATION 2111 JEFFERSON DAVIS HIGHWAY #412, NORTH ARLINGTON, VA 22202			SCHILLING, RICHARD L	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 01/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,183

Applicant(s)

MIFUNE, HIROYUKI

Examiner

Richard L. Schilling

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-32 is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Applicant's petition for a claim to priority under 37 CFR 1.78(a)(3) has been received and granted. A new oath for a continuation-in-part application is now required along with any claims of foreign priority based on the parent application. The new oath must acknowledge the duty to disclose all information known to be material to patentability as defined in 37 CFR 1.56 which became available between the filing dates of the prior parent application and the CIP application.

2. Claims 2, 4-8 and 12 are rejected under 35 U.S.C. ' 102(a) and (e) as being anticipated by Yabuki et al. The rationale of this rejection is set forth in item No. 2 of the first Office action filed June 25, 2004. Since the instant application is a continuation-in-part of Application Serial No. 10/285,644 to Oka et al., claims 1, 3, 9-11 and 13-17 have the benefit of the filing date of the application to Oka et al. which contains a written description of the invention set forth in instant claims 1, 3, 9-11 and 13-17. The application to Oka et al. (see PG Pub 2003/0232288) discloses elements comprising organic silver salts, silver halide with over 40% silver iodide and reduction sensitizing during formation of the silver halide. The silver halide emulsions are preferably made separately from the organic silver salt compositions and then mixed. Paragraph 737 of Oka et al. '288 discloses the grain size of instant claim 13. Paragraph 733 of Oka et al. discloses the preferred range of 80-100 mole percent of silver iodide of instant claim 11. Oka et al. also discloses chalcogen sensitizing in addition to reduction sensitizing as required by instant claims 9 and 10. The grains in Oka et al. may be tabular grains as in instant claim 14; and the silver halide emulsions of Oka et al. may comprise compounds that generate two electrons as in instant claim 15 or reducing compounds with absorptive groups as in instant claim 16. However, the application to Oka et al. does not set forth a written description, within the meaning of the first paragraph of 35 U.S.C. ' 112, of reduction sensitizing in the presence of all of the ions as required by instant claims 2 and 4-7. Oka et al. also does not disclose silver halide grains reduction sensitized at the pAg range required by instant claim 8. Oka et al. also does not disclose silver halide grains having silver bromide or silver chloride at the full range of 1 mole percent to 10 mole percent required by instant claim 12. Since the U.S. application to Oka et al. does not contain a written description of the full scope of the subject matter set forth in instant claims 2, 4-8 and 12, claims 2, 4-8 and 12 are not entitled under 35 U.S.C. ' 120 to the benefit of the filing date of U.S. Application Serial No. 10/285,644 to Oka et al.

3. Claims 2, 4-8 and 12 are rejected under 35 U.S.C. ' 102(a) and (e) as being anticipated by Yabuki et al.

102(e) as being anticipated by Yamamoto '175, Oka et al. '925 or Oka et al. '288. The rationale of this rejection is found in paragraph 3 of the first Office action incorporated herein by reference. The instant claims are not entitled to the benefit of parent Application Serial No. 10/285,644 as explained in paragraph 2 above.

4. Claims 2, 4-8 and 12 are rejected under 35 U.S.C. ' 102(a) as being anticipated by Oka et al. '288. The rationale of this rejection is set forth in paragraph 4 of the first Office action incorporated herein by reference. The instant claims are not entitled to the benefit of Application Serial No. 10/285,644 for the reasons set forth in paragraph 2 above.

5. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent.

In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-43 of copending application Serial No. 10/285,644. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims encompass the subject matter of claims 18-43 of U.S. Patent Application 10/285,644. Claims 26-28 and 36-43 of the copending application have claimed subject matter directed to silver halide emulsions with silver halide grains containing over 40% silver iodide

which are reduction sensitized. According to the specification of the copending application (e.g. paragraph 243 of PG Pub 2003/0232288), reduction sensitizing is carried out preferably while the grains are being formed.

This is a provisional obviousness-type double patenting

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rejection because the conflicting claims have not in fact been patented.

6. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. ' 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. ' 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. ' 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

7. The amendment and petition to make the instant application a continuation-in-part application necessitated the obvious-type double patenting rejection.

8. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc
January 11, 2005

RICHARD L. SCHILLING
PRINCIPAL EXAMINER

DATE: 1/11/05

